



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|--------------------------|-----------------------------|------------------|
| 10/706,760 | 11/12/2003 | Joseph I. Weinschenk III | 2365A US | 7809 |
| 26356 | 7590 | 05/26/2006 | | |
| ALCON RESEARCH, LTD. R&D COUNSEL, Q-148 6201 SOUTH FREEWAY FORT WORTH, TX 76134-2099 | | | EXAMINER WILLSE, DAVID H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3738 | |

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/706,760 | Applicant(s) WEINSCHENK ET AL. | |
| | Examiner Dave Willse | Art Unit 3738 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3738

The disclosure is objected to because of the following informalities: On page 3, line 22, "increased" should be replaced by --increase--; on line 24, "section" should be replaced by --sections--. On page 6, line 21, "undergoes" should be replaced by --undergo--. Appropriate correction is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bagrov et al., SU 1635981 A1, which discloses an optic 1 in the form of an intraocular lens and another optic in the form of a posterior capsule (Figure 5). The columns 4 are made of a collagen hydrogel expansive material (Derwent abstract, lines 1-4) and join the optic 1 to the capsule (Derwent abstract, lines 5-6) outside of the optical zones (Figure 5).

Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bagrov et al., SU 1635981 A1. The optic 1 comprising any of a soft acrylic, a hydrogel, and a silicone, all quite common in the art at the time of the present invention, would have been obvious in order to facilitate insertion into the eye through a small incision by folding the optic 1, which may be viewed as either the "first" optic or the "second" optic as claimed.

Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bagrov et al., SU 1635981 A1, in view of Laguette et al., US 6,478,821 B1. Regarding claim 2, masked hydrogels were known in the art (Laguette et al.: column 9, lines 8-13), and to incorporate such a mask on the collagen hydrogel taught by Bagrov et al. would have been obvious in order to prevent premature swelling of the columns prior to placement and orientation within the capsular bag, with further motivation having been provided by both references being directed to columnar structures for affixing to natural features within an eye. Regarding claim 4, an acrylamide polymer would have been obvious from its suitability for such columnar structures (Laguette et al.: column 8, line 60, through column 9, line 2).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bagrov et al., SU 1635981 A1, in view of Vanderbilt, US 6,329,485. The columns 4 of Bagrov et al. being of a cross-linked copolymer of 2-phenylethyl acrylate and 2-phenylethyl methacrylate would have been an obvious material alternative in view of advantageous properties pertaining to biocompatibility, foldability, and so on as taught, for example, by Vanderbilt (column 3, lines 19-31 and 43-49; column 6, lines 27-30; column 10, lines 53-57; column 15, lines 28-32), with further motivation having been provided by the goal of Bagrov et al. to reduce trauma during implantation (Derwent abstract, lines 7-8).

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bagrov et al., SU 1635981 A1, in view of Hodd et al., WO 99/47185 A2. Likewise, expansive materials involving acrylamide and anhydride-containing polymers were known in the art (Hodd et al.: page 7, lines 33-37; page 8, lines 19-24; etc.) and would have been obvious from their advantages pertaining to modulus adjustment (page 13, lines 20-23), biocompatibility, and so on,

Art Unit: 3738

with further motivation having been provided by the Hodd et al. method encompassing conventional molding of various types of intraocular lenses (page 4, lines 33-38). Regarding claim 7, scission of the anhydride moieties would have been obvious in order to modify the level of hydration and hence the physical characteristics of the Bagrov et al. expansive columns.

The Applicant's remarks have been reviewed. The Applicant apparently asserts that the posterior capsule is not an optic. The term "optic" is defined as "[a] component of an optical instrument" (*Webster's II New Riverside University Dictionary*, 1984), "any of the elements (as lenses, mirrors, or light guides) of an optical instrument or system -- usually used in plural" (*Merriam-Webster Online Dictionary*), or "a lens or other part of an optical instrument that interacts with light" (*Wiktionary*). None of these definitions require that an optic have a non-zero optical power, nor does the Applicant's original disclosure include a definition of the word "optic" in a manner prescribed by MPEP § 2111.01. The examiner has given the claims their broadest reasonable interpretation consistent with the specification (MPEP § 2111); it is the Applicant's burden to precisely define the invention, and not the examiner's (*In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997)).


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 3738

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Dave Willse
Primary Examiner
Art Unit 3738